

## REMARKS

### **I. General**

Claims 1-19 and 21-36 are pending in the current application. No amendments are being made to the claims at this time. The issues raised by the Office Action mailed July 26, 2005 are:

- Claims 1-19 are rejected under 35 U.S.C. § 101, as being directed to non-statutory subject matter;
- Claims 1-13, 16-19, and 21-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bigus et. al.* (U.S. Patent No. 6,401,080, hereinafter *Bigus*) in view of *Roderick* (U.S. Patent No. 6,605,121, hereinafter *Roderick*), in further view of *Parunak et al.* (U.S. Patent Application Publication No. 20020013631, hereinafter *Parunak*);
- Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bigus* in view of *Roderick*, in view of *Parunak*, and in further view of *Ausubel* (U.S. Patent No. 5,905,975, hereinafter *Ausubel*); and
- Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bigus* in view of *Roderick*, in view of *Parunak*, and in further view of *Shkedy* (U.S. Patent No. 6,260,024, hereinafter *Shkedy*).

In response, Applicants respectfully traverse the outstanding claim rejections, and request reconsideration and withdrawal in light of the remarks presented herein.

### **II. Claim Rejections Under 35 U.S.C. § 101**

The Office Action rejects claims 1-19 under 35 U.S.C. § 101 as non-statutory because “the method claims as presented do not claim a technological basis.” Office Action, page 2. The Examiner relies on the content and reasoning of the non-precedential opinion in *Bowman* to support this rejection. Office Action, page 2, citing *Ex Parte Bowman*, 61 U.S.P.Q.2d 1669 (Bd. Pat. App. & Inter. 2001). In *Bowman*, the Board of Patent Appeals and Interferences sustained the Examiner’s rationale that the claimed invention did not “fall within the technological arts because no form of technology [was] disclosed or claimed.” *Bowman*, 61 U.S.P.Q.2d at 1671. However, Applicants assert that, in the current application, a form of technology is both disclosed and claimed.

Claim 1 requires “[a] method for conducting an electronic negotiation,” claim 17 requires “[a] method for electronically negotiating a commercial transaction,” and claims 2-16 and 18-19 depend from base claims 1 and 17. Hence, each of claims 1-19 requires a method for an electronic process, which is a form of technology that falls within the technological arts. Moreover, support for a technological basis can be found throughout the specification, for example, on page 1, lines 5-24 (e.g., electronic negotiations, internet, e-commerce, technology, protocol, software, etc.); page 2, lns. 28-29 (e.g., code); and page 3, lns. 1-15 (e.g., negotiation protocol conducted over the internet). In *Bowman*, the claimed invention was rejected as non-statutory because the use of a computer to perform the process was neither in the claims nor described in the specification. *Bowman*, 61 U.S.P.Q.2d at 1671. In the current application, however, the technology is claimed and described. Accordingly, Applicants assert that claims 1-19 describe patentable subject matter under 35 U.S.C. § 101, and respectfully request that the rejection be withdrawn.

### **III. Claim Rejections Under 35 U.S.C. § 103(a)**

To rely on a reference under 35 U.S.C. § 103(a), the reference must be analogous prior art. M.P.E.P. § 2141.01(a). The reference “must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). In addition, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Applicants assert that the Examiner’s rejections fail to meet the basic criteria.

#### **A. Claims 1-13, 16-19, and 21-36**

Claims 1-13, 16-19, and 21-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bigus* in view of *Roderick*, in further view of *Parunak*.

### Combination of Non-Analogous Prior Art References

The present invention is in the field of electronic commerce (page 1), and claims 1-13 and 16-19 are directed to protocols for the conduct of electronic negotiations. *Parunak* discloses a method for determining assignments based upon constraint optimization techniques. Paragraph [0001]. As such, the teachings of *Parunak* are pertinent to areas such as product design, manufacturing scheduling, route planning, logistics management, organizational design, or where constraint satisfaction problems exist. Paragraphs [0032], [0049]. However, *Parunak* is not in the field of Applicants' endeavor and it is not reasonably pertinent to the particular problem with which the present invention is concerned, at least, because constraint satisfaction problems are not applicable to electronic commerce. Accordingly, Applicants assert that *Parunak* is non-analogous prior art, and that at least for this reason, claims 1-13, 16-19, and 21-36 are patentable over the 35 U.S.C. § 103(a) rejection of record.

### Lack of Motivation

In support for the combination of *Bigus* and *Roderick* with *Parunak*, the Examiner states that “[i]t would have been obvious to one with ordinary skill in the art to include a look-up for comparing for [sic] negotiation parties because *Parunak* et al teaches coordination [sic] required between multiple buyers and sellers (para 0186).” Office Action, page 6. However, Applicants point out that neither of claims 1-13, 16-19, and 21-36 require “a look-up for comparing for [sic] negotiation parties” and/or “coordination [sic] ... between multiple buyers and sellers,” as put forth by the Examiner. Therefore, the Examiner has not provided an appropriate suggestion or motivation to combine the cited references. Applicants assert that no motivation exists either in the references or in the knowledge generally available to one of ordinary skill in the art for combining the teachings of *Bigus* and *Roderick* with the teachings of *Parunak*, and the Examiner has failed to establish a prima facie case for rejecting claims 1-13, 16-19, and 21-36. Accordingly, Applicants respectfully assert that, at least for the above reasons, claims 1-13, 16-19, and 21-36 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Lack of All Claimed Limitations

Claim 1 requires, in part, “a step of offering, wherein the second negotiating party offers to negotiate one or more attributes for the product listed in the advertisement; a step of counter-offering, wherein the first negotiating party responds to the offer with a first counter-offer; and a step of displaying at least one of a second set of attribute-value pairs to the second negotiating party.” The Examiner mistakenly characterizes *Bigus* as teaching that:

“a second negotiating party offers to negotiate one or more attributes for the product listed in the guide ... parties continue to exchange counter offers until each attribute is agreed to ....” Office Action, page 5.

Applicants assert that *Bigus* teaches negotiating a price, but it does not teach or suggest negotiating one or more product attributes, as required by claim 1. Col. 8, lns. 53-54; cols. 10-18; figs. 5-6. In fact, *Bigus* merely teaches a method that includes deciding which price to offer or to accept in a particular transaction based on a database of products and values. Col. 19, lns. 3-10 and 55-56. However, claim 1 requires actually negotiating one or more product attributes. No section of *Bigus*, *Roderick*, or *Parunak* teaches or suggests negotiating a product attribute of a set of attribute-value pairs, as required by claim 1. Therefore, at least for the above reasons, the combination of *Bigus*, *Roderick*, and *Parunak* does not teach or suggest all of the claimed limitations.

Claim 1 also requires, in part, “a step of advertising ... the advertisement comprising a set of attribute-value pairs, each attribute-value pair including an attribute and a range of values for the attribute, for the product listed in the advertisement.” The Examiner admits that *Bigus* does not teach or suggest this limitation, but contends that *Roderick* discloses “advertisements that may be part of a buyers guide (col 12, lines 36-55) and listings by a negotiating party (col 10, lines 55-66).” Office Action, page 5. At the passages cited by the Examiner, *Roderick* teaches:

“... the user requesting the product ... learned of the information page through an advertisement in a particular publication ....” Col. 12, lns. 44-46.

However, this is not the same limitation as the claimed limitation. More specifically, the cited passages do not teach or suggest an advertisement comprising a set of attribute-value pairs, each attribute-value pair including an attribute and a range of values for the attribute for

the product listed, as required by claim 1. *Roderick* merely teaches the user finding out about the URL address of the information page through an advertisement. It does not advertise a set of attribute-value pairs, nor does it advertise a range of values therefor. Therefore, at least for the above reasons, the combination of *Bigus*, *Roderick*, and *Parunak* does not teach or suggest all of the claimed limitations, and the 35 U.S.C. § 103(a) rejection of claim 1 should be withdrawn.

Claim 1 also requires, in part, “a step of looking up, wherein the product listed in the advertisement is located for a second negotiating party.” The Examiner admits that *Bigus* in view of *Roderick* does not teach or suggest this limitation, but contends that *Parunak* discloses “a look-up for comparing the sale and buying [sic] for negotiation.” Office Action, page 6. At the passage cited by the Examiner, *Parunak* teaches:

“A variable agent also performs the functionality of block 260 wherein the variable agent compares the offerings of multiple constraint agents that competing on one side of the transaction (e.g., sellers) and presents a summary and recommendation to the constraint agents on the other side (e.g., buyers). As indicated at block 264, the variable agent summarizes the bids on the one side of a transaction (e.g., the sellers[sic]) in terms of a representation of their relative overlap with the other side of the transaction and the maximum possible gain of utility over cost that they offer the other side.” Paragraph [0091].

In other words, *Parunak* teaches an agent that compares offerings of multiple sellers and presents a summary and recommendation to the buyers’ agents. However, this is not the same limitation as the claimed limitation. More specifically, the cited passage does not teach or suggest looking up or locating a product listed in an advertisement. *Parunak* does not teach or suggest the step of looking up, wherein the product listed in the advertisement is located, as required by claim 1. Therefore, at least for the above reasons, the combination of *Bigus*, *Roderick*, and *Parunak* does not teach or suggest all of the claimed limitations, and the 35 U.S.C. § 103(a) rejection of claim 1 should be withdrawn.

Claim 1 further requires, in part, “a step of displaying at least one of a second set of attribute-value pairs to the second negotiating party ....” The Examiner does not rely on *Bigus*, *Roderick*, or *Parunak* as teaching or suggesting this limitation. Applicants assert that the cited references, taken alone or in combination, do not teach or suggest this element of

claim 1. Therefore, at least for the above reasons, the combination of *Bigus*, *Roderick*, and *Parunak* does not teach or suggest all of the claimed limitations, and the 35 U.S.C. § 103(a) rejection of claim 1 should be withdrawn.

Claims 2-13 and 16 are dependent, directly or indirectly, from base claim 1, and thus inherit all of its limitations. As noted above, the combination of *Bigus*, *Roderick*, and *Parunak* fails to teach or suggest all of the limitations of base claim 1. Consequently, the combination of references also fails to teach or suggest all of the limitations of claims 2-13 and 16. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of claims 2-13 and 16.

Claim 17 requires, in part, “[an] advertising step compris[ing] listing a set of attribute-value pairs for the product, wherein each attribute-value pair includes an attribute and a negotiable list of values for the attribute.” As noted above, *Bigus* only teaches negotiating a price, but does not teach or suggest negotiating each attribute of a set of attribute-value pairs, as required by claim 17. Neither *Bigus*, *Roderick*, *Parunak*, nor any combination thereof, teaches or suggests this claimed limitation. Therefore, at least for the above reasons, the combination of cited references does not teach or suggest all of the claimed limitations. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of claim 17.

Claim 17 also requires, in part, “offering to electronically negotiate one or more attributes from the attribute-value pairs for the product, wherein the offering step comprises proposing the second negotiating party’s list of values for a first attribute from the set of attribute-value pairs.” The Examiner does not rely on *Bigus*, *Roderick*, or *Parunak* as teaching or suggesting this limitation. Applicants assert that the cited references, taken alone or in combination, do not teach or suggest this element of claim 17. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of claim 17.

Claim 17 further requires, in part, “conducting one or more additional countering steps until one of: each attribute from the attribute-value pairs is agreed to, and the failed negotiation is declared, wherein the second negotiating party and the first negotiating party

alternate conducting the countering steps until one of: each attribute from the attribute-value pairs is agreed to, and the failed negotiation is declared.” The Examiner does not rely on *Bigus*, *Roderick*, or *Parunak* as teaching or suggesting this limitation. Applicants assert that the cited references, taken alone or in combination, do not teach or suggest this element of claim 17. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of claim 17.

Claims 18 and 19 depend, directly or indirectly, from base claim 17, and thus inherit all of its limitations. As noted above, the combination of *Bigus*, *Roderick*, and *Parunak* fails to teach or suggest all of the limitations of base claim 17. Consequently, the combination of *Bigus*, *Roderick*, and *Parunak* also fails to teach or suggest all of the limitations of claims 18 and 19. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of claims 18 and 19.

Claim 21 requires, in part, “code for advertising a product that is to be electronically negotiated wherein said product is listed by a first negotiating party and said code for advertising operates to produce an advertisement comprising a set of attribute-value pairs, each attribute-value pair including an attribute and a range of values for the attribute, for the product listed in the advertisement.” The Examiner admits that *Bigus* does not teach or suggest this limitation, but contends that *Roderick* discloses “advertisements that may be part of a buyers guide (col 12, lines 36-55) and listings by a negotiating party (col 10, lines 55-66).” Office Action, page 5. At the passages cited by the Examiner, *Roderick* teaches:

“... the user requesting the product ... learned of the information page through an advertisement in a particular publication ....” Col. 12, lns. 44-46.

However, this is not the same limitation as the claimed limitation. More specifically, the cited passages do not teach or suggest a code for advertising that operates to produce an advertisement comprising a set of attribute-value pairs, each attribute-value pair including an attribute and a range of values for the attribute, for the product listed in the advertisement, as required by claim 21. *Roderick* merely teaches the user finding out about the URL address of the information page through an advertisement. It does not advertise a set of attribute-value pairs, nor does it advertise a range of values therefor. Therefore, at least for the above

reasons, the combination of *Bigus*, *Roderick*, and *Parunak* does not teach or suggest all of the claimed limitations, and the 35 U.S.C. § 103(a) rejection of claim 21 should be withdrawn.

Claim 21 also requires, in part, “code for looking-up said product listed in said advertisement for a second negotiating party, wherein at least one of a first set of attribute-value pairs is displayed to said second negotiating party.” The Examiner admits that *Bigus* in view of *Roderick* does not teach or suggest this limitation, but contends that *Parunak* discloses “a look-up for comparing the sale and buying [sic] for negotiation.” Office Action, page 6. At the passage cited by the Examiner, *Parunak* teaches:

“A variable agent also performs the functionality of block 260 wherein the variable agent compares the offerings of multiple constraint agents that competing on one side of the transaction (e.g., sellers) and presents a summary and recommendation to the constraint agents on the other side (e.g., buyers). As indicated at block 264, the variable agent summarizes the bids on the one side of a transaction (e.g., the sellers[sic]) in terms of a representation of their relative overlap with the other side of the transaction and the maximum possible gain of utility over cost that they offer the other side.” Paragraph [0091].

In other words, *Parunak* teaches an agent that compares offerings of multiple sellers and presents a summary and recommendation to the buyers’ agents. However, this is not the same limitation as the claimed limitation. More specifically, the cited passage does not teach or suggest looking up or locating a product listed in an advertisement. *Parunak* does not teach or suggest code for looking-up a product listed in an advertisement for a second negotiating party, wherein at least one of a first set of attribute-value pairs is displayed to a second negotiating party, as required by claim 21. Therefore, at least for the above reasons, the combination of *Bigus*, *Roderick*, and *Parunak* does not teach or suggest all of the claimed limitations, and the 35 U.S.C. § 103(a) rejection of claim 21 should be withdrawn.

Claims 22-36 are dependent, directly or indirectly, from base claim 21, and thus inherit all of its limitations. As noted above, the combination of *Bigus*, *Roderick*, and *Parunak* fails to teach or suggest all of the limitations of base claim 21. Consequently, the combination of references also fails to teach or suggest all of the limitations of claims 22-36. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of claims 22-36.

**B. Claim 14**

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bigus* in view of *Roderick*, in view of *Parunak*, and in further view of *Ausubel*.

Combination of Non-Analogous Prior Art References

The present invention is in the field of electronic commerce (page 1), and claim 14 is directed to protocols for the conduct of electronic negotiations. As noted above, *Parunak* discloses a method for determining assignments based upon constraint optimization techniques. Paragraph [0001]. As such, the teachings of *Parunak* are pertinent to areas such as product design, manufacturing scheduling, route planning, logistics management, organizational design, or where constraint satisfaction problems exist. Paragraphs [0032], [0049]. However, *Parunak* is not in the field of Applicants' endeavor and it is not reasonably pertinent to the particular problem with which the present invention is concerned, at least, because constraint satisfaction problems do not exist in electronic commerce. Accordingly, Applicants assert that *Parunak* is non-analogous prior art, and that at least for this reason, claim 14 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Lack of Motivation

In support for the combination of *Bigus*, *Roderick*, and *Ausubel* with *Parunak*, the Examiner states that “[i]t would have been obvious to one with ordinary skill in the art to include a look-up for comparing for [sic] negotiation parties because Parunak et al teaches coordination [sic] required between multiple buyers and sellers (para 0186).” Office Action, page 6. However, Applicants point out that claim 14 does not require “a look-up for comparing for [sic] negotiation parties” and/or “coordination [sic] ... between multiple buyers and sellers,” as put forth by the Examiner. Therefore, the Examiner has not provided an appropriate suggestion or motivation to combine the cited references. Applicants assert that no motivation exists either in the references or in the knowledge generally available to one of ordinary skill in the art for combining the teachings of *Bigus*, *Roderick*, and *Ausubel* with the teachings of *Parunak*, and the Examiner has failed to establish a prima facie case for rejecting claim 14. Accordingly, Applicants respectfully assert that, at least for the above reasons, claim 14 is patentable over the 35 U.S.C. § 103(a) rejection of record.

### Lack of All Claimed Limitations

Claim 1 requires, in part, “a step of offering, wherein the second negotiating party offers to negotiate one or more attributes for the product listed in the advertisement; a step of counter-offering, wherein the first negotiating party responds to the offer with a first counter-offer; and a step of displaying at least one of a second set of attribute-value pairs to the second negotiating party.” Claim 1 also requires, in part, “a step of looking up, wherein the product listed in the advertisement is located for a second negotiating party.” In addition, Claim 1 requires, in part, “a step of displaying at least one of a second set of attribute-value pairs to the second negotiating party.” As noted above, *Bigus* does not teach or suggest, at least, these elements of claim 1. Applicants assert that neither *Roderick*, *Parunak*, nor *Ausubel* teach or suggest this limitation, and notes that the Examiner does not rely on *Roderick*, *Parunak* or *Ausubel* as doing so. Hence, the combination of *Bigus*, *Roderick*, *Parunak*, and *Ausubel* does not teach or suggest every limitation of claim 1. Claim 14 depends directly from base claim 1, and thus inherits all of its limitations. Therefore, the combination of *Bigus*, *Roderick*, *Parunak*, and *Ausubel* does not teach or suggest every limitation of claim 14. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claim 14.

### **C. Claim 15**

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bigus* in view of *Roderick*, in view of *Parunak*, and in further view of *Shkedy*.

### Combination of Non-Analogous Prior Art References

The present invention is in the field of electronic commerce (page 1), and claim 15 is directed to protocols for the conduct of electronic negotiations. As noted above, *Parunak* discloses a method for determining assignments based upon constraint optimization techniques. Paragraph [0001]. As such, the teachings of *Parunak* are pertinent to areas such as product design, manufacturing scheduling, route planning, logistics management, organizational design, or where constraint satisfaction problems exist. Paragraphs [0032], [0049]. However, *Parunak* is not in the field of Applicants’ endeavor and it is not reasonably pertinent to the particular problem with which the present invention is concerned, at least,

because constraint satisfaction problems do not exist in electronic commerce. Accordingly, Applicants assert that *Parunak* is non-analogous prior art, and that at least for this reason, claim 15 is patentable over the 35 U.S.C. § 103(a) rejection of record.

#### Lack of Motivation

In support for the combination of *Bigus*, *Roderick*, and *Shkedy* with *Parunak*, the Examiner states that “[i]t would have been obvious to one with ordinary skill in the art to include a look-up for comparing for [sic] negotiation parties because Parunak et al teaches coordination [sic] required between multiple buyers and sellers (para 0186).” Office Action, page 6. However, Applicants point out that claim 14 does not require “a look-up for comparing for [sic] negotiation parties” and/or “coordination [sic] ... between multiple buyers and sellers,” as put forth by the Examiner. Therefore, the Examiner has not provided an appropriate suggestion or motivation to combine the cited references. Applicants assert that no motivation exists either in the references or in the knowledge generally available to one of ordinary skill in the art for combining the teachings of *Bigus*, *Roderick*, and *Shkedy* with the teachings of *Parunak*, and the Examiner has failed to establish a prima facie case for rejecting claim 14. Accordingly, Applicants respectfully assert that, at least for the above reasons, claim 14 is patentable over the 35 U.S.C. § 103(a) rejection of record.

#### Lack of All Claimed Limitations

Claim 1 requires, in part, “a step of offering, wherein the second negotiating party offers to negotiate one or more attributes for the product listed in the advertisement; a step of counter-offering, wherein the first negotiating party responds to the offer with a first counter-offer; and a step of displaying at least one of a second set of attribute-value pairs to the second negotiating party.” Claim 1 also requires, in part, “a step of looking up, wherein the product listed in the advertisement is located for a second negotiating party.” In addition, Claim 1 requires, in part, “a step of displaying at least one of a second set of attribute-value pairs to the second negotiating party.” As noted above, *Bigus* does not teach or suggest, at least, these elements of claim 1. Applicants assert that neither *Roderick*, *Parunak*, nor *Shkedy* teach or suggest this limitation, and notes that the Examiner does not rely on *Roderick*, *Parunak*, or *Shkedy* as doing so. Hence, the combination of *Bigus*, *Roderick*, *Parunak*, and

*Shkedy* does not teach or suggest every limitation of claim 1. Claim 15 depends directly from base claim 1, and thus inherits all of its limitations. Therefore, the combination of *Bigus*, *Roderick*, *Parunak*, and *Shkedy* does not teach or suggest every limitation of claim 15. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claim 15.

#### IV. Conclusion

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10992554-1, from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482724993US, in an envelope addressed to: MS Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.


Date of Deposit: October 21, 2005

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Respectfully submitted,

By 

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